520.38929CX1

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Applicants: M. INOUE, et al

Serial No.: 09/933,801

Filed: August 22, 2001

For: PROGRAM WRITABLE IC CARD AND METHOD THEREOF

Group: 2135

Examiner: P. Klimach

RESPONSE

May 17, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following is in response to the January 16, 2004 Office Action.

The present application has pending claims 2-15. No amendments were made to the claims.

Applicants note that the Examiner did not consider the Information Disclosure Statement filed on August 22, 2001 along with the present application. A copy of said Information Disclosure Statement is attached herewith. The August 22, 2001 Information Disclosure Statement provided a listing of the references cited in the parent application. An indication that these references have been considered is respectfully requested.

In the Office Action the Examiner rejected claims 2-15 under 35 USC §103(a) as being unpatentable over Hirokawa (U.S. Patent No. 4,827,512) in view of

PAGE 4/8 * RCVD AT 7/20/2004 8:59:25 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/4 * DNIS:8729306 * CSID:703 312 6666 * DURATION (mm-ss):05-02

Kuriyama (U.S. Patent No. 5,202,923). This rejection is traversed for the following reasons. Applicants submit that the features of the present invention as recited in claims 2-15 are not taught or suggested by Hirokawa or Kuriyama whether taken individually or in combination with each other as suggested by the Examiner. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

In the Office Action the Examiner used Hirokawa as the primary reference to reject the claims of the present application and alleged that Hirokawa discloses various features corresponding to different limitations as recited in the claims.

However, the allegations used by the Examiner in the Office Action are the very same allegations made by the Examiner during the prosecution and Appeal of Application Serial No. 08/904,137, now U.S. Patent No. 6,732,272 that was soundly rejected by the Board of Patent Appeals and Interferences. To aid in the Examiner's understanding, attached herewith are copies of the Appeal Brief, Reply Brief and Decision on Appeal filed by Applicants and entered by the Board during the Appeal of Application Serial No. 08/904,137.

In the Office Action for the present application the Examiner alleges without any support that:

> "it is disclosed that programs that are inputted from an external device are normally encrypted. The decryption function in the card allows for the encrypted program to be decrypted and used (see col. 1, lines 25-28). Col. 5, lines 45-49 and col. 6, lines 38-40 also disclose a decoding function. The recited first program is the system programs already stored on the card. The decoding function along with the disclosure of programs being encrypted if externally inputted, meets the recitations of decryption function. The encrypted program

> that is externally inputted and decrypted before storing in a memory area meets the recitation of first memory, second memory and third memory".

The above noted allegations by the Examiner in the outstanding Office Action for the present application are the very same allegations made by the Examiner during prosecution and appeal of Application Serial No. 08/904,137. The Board completely rejected these allegations and specifically stated, for example, on page 4, beginning in the first full paragraph that:

> "we agree with Appellants' that Hirokawa fails to disclose decrypting a program for storage on an IC card. When presented with the argument that Hirokawa discloses that encrypting/decrypting section 39 is strictly for decrypting "data" the Examiner points to col. 6, lines 1-5 as support for finding that the reference describes the "data" memory as storing both data and programs. (Answer at 6)".
>
> "Hirokawa at col. 6, lines 1 through 5, however, refers to the correspondence tables of Figs. 14a and 14b which are stored in data memory 43. The programs themselves are not stored in data memory 43 but in program memory 45. Hirokawa's second embodiment is directed to updating data memory 43, rather than the program memory in which the function programs resides".
>
> Hirokawa, in the second embodiment refers to transferring "instruction data" (e.g., col. 6, lines 37-42). We acknowledge that a program may be considered as a form of "data" at least in the context of the program being transferred for storage in a card memory (e.g., lines 28-37). In particular, in Hirokawa's first embodiment, a user may add ones own program to the IC card, with the program that is to be stored being contained within a string of command text (Fig. 4). In Hirokawa's second embodiment, relevant to the "encryption", data memory 43 may be used for storing "various data" (col. 5, lines 60-61). Further, instruction data in that embodiment may contain a function code, or the function code and data (col. 6, lines 21-25; Figs. 16a and 16b). However, Hirokawa does not disclose that the data transferred in

PAGE 6/8 * RCVD AT 7/20/2004 8:59:25 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/4 * DNIS:8729306 * CSID:703 312 6666 * DURATION (mm-ss):05-02

the second embodiment is for storage on the IC card in form of an executable program, much less decryption of a program storage on the card. [Emphasis added]".

The Examiner is strongly urged to review and completely understand the holding by the Board in the Decision on Appeal for Application Serial No. 08/904,137. This holding applies to the present situation since the claims which are being examined by the Examiner in the present application contain the very same limitations addressed by the Board as not being taught or suggested by Hirokawa.

Thus, it is quite apparent that Hirokawa does not teach or suggest numerous features of the present invention as recited in the claims. These deficiencies of Hirokawa are not supplied by Kuriyama. Therefore, combining the teachings of Hirokawa and Kuriyama in the manner suggested by the Examiner in the Office Action still fails to teach or suggest the features of the present invention as now more clearly recited in the claims.

Kuriyama is merely relied upon by the Examiner for an alleged teaching of an error checking function for checking that sub-programs stored in memory are not incorrect. It is quite clear that this alleged teaching of Kuriyama does not supply the numerous deficiencies of Hirokawa shown above. Therefore, combining the teachings of Hirokawa with Kuriyama still fails to teach or suggest the features of the present invention as now more clearly recited in the claims.

Thus, Hirokawa and Kuriyama whether taken individually or in combination do not anticipate nor render obvious the features of the present invention as recited in the claims. Therefore, reconsideration and withdrawal of the 35 USC §103(a)

PAGE 7/8 * RCVD AT 7/20/2004 8:59:25 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/4 * DNIS:8729306 * CSID:703 312 6666 * DURATION (mm-ss):05-02

rejection of claims 2-15 as being unpatentable over Hirokawa in view of Kuriyama is respectfully requested.

In view of the foregoing remarks, Applicants submit that claims 2-15 are in condition for allowance. Accordingly, early allowance of the present application based on claims 2-15 is respectfully requested.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (520.38929CX1).

Respectfully submitted,

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PAGE 8/8 * RCVD AT 7/20/2004 8:59:25 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/4 * DNIS:8729306 * CSID:703 312 6666 * DURATION (mm-ss):05-02